

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant:	William Wadleigh	Examiner:	Paul D'Agostino
Serial No.:	10/659,581	Group Art Unit:	3714
Filed:	September 9, 2003	Docket No.:	1842.002US1
Customer No.:	70648	Confirmation No.:	4658
Title:	ELECTRONIC GAME AND SYSTEM HAVING OVERLAYED VIDEO IMAGES		

REPLY BRIEF UNDER 37 C.F.R. § 41.41

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
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APPELLANT'S REPLY BRIEF

This Reply Brief is filed in response to the Examiner's Answer (hereinafter, the "Answer"), mailed March 4, 2011, and supplements the Appeal Brief filed by the Appellant on July 22, 2010. Appellant hereby requests that the appeal of the present application be maintained. This Reply Brief addresses each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and is filed in compliance with the requirements of 37 CFR 41.37(c). Please charge any required additional fees or credit overpayments to Deposit Account 19-0743.

STATUS OF THE CLAIMS

The present application was filed on September 9, 2003 with claims 1-52. In response to a Non-Final Office Action mailed on February 2, 2007, Appellant canceled claims 9, 19, 26, 35, 40, and 49. Claims 53-58 were added in a Request for Continued Examination filed in response to a first Final Office Action mailed September 20, 2007 that rejected claims 1-8, 10-18, 20-25, 27-33, 35-39, 41-48, and 50-52. A second Non-Final Office Action mailed September 8, 2008 rejected claims 1-8, 10-18, 20-25, 27-33, 35-39, 41-48, and 50-58. A second Final Office Action with a notification date of August 20, 2009 rejected claims 1-8, 10-18, 20-25, 27-33, 35-39, 41-48, and 50-58. The rejections of the second Final Office Action were appealed in the present action.

In the present appeal, the Answer of March 4, 2011 withdrew rejections based on the grounds of non-statutory obviousness-type double patenting and failure to comply with the written description requirement of 35 U.S.C. §112. The Answer, however, provided new grounds of rejection under 35 U.S.C. §101, and maintained previous rejections under 35 U.S.C. §102 and §103. Claims 1-8, 10-18, 20-25, 27-33, 35-39, 41-48, and 50-58 stand twice rejected, remain pending, and remain the subject of the present appeal.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

In addition to the non-withdrawn Grounds of Rejection to be Reviewed on Appeal as set forth in Appellant's Appeal Brief, Appellant submits the following ground of rejection to be reviewed, based on the new ground of rejection provided in the Answer:

Claims 38-43 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

ARGUMENT

The Appellant has reviewed the Answer, and believes the statements in the Appeal Brief remain accurate and compelling. In responding to the Answer, the Appellant wishes to address the New Ground of Rejection under 35 U.S.C. § 101, and rebut a selected few of the points raised in the Answer for the Rejections under 35 U.S.C. § 102 and § 103.

A) The Applicable Law under 35 U.S.C. § 101

The four statutory categories of subject matter under 35 U.S.C. § 101 are “process, machine, manufacture or composition of matter.” A claim to a non-transitory, tangible computer readable storage medium “that possesses structural limitations under the broadest reasonable interpretation standard to qualify as a manufacture would be patent-eligible subject matter.” See Interim Examination Instructions for Evaluating Subject Matter Eligibility under 35 U.S.C. § 101, Aug. 24, 2009, p. 4.

As further explained in the January 26, 2010 memorandum from USPTO Director David J. Kappos entitled “Subject Matter Eligibility of Computer Readable Media”:

The United States Patent and Trademark Office (USPTO) is obliged to give claims their broadest reasonable interpretation consistent with the specification during proceedings before the USPTO. See *In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989) (during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow). The broadest reasonable interpretation of a claim drawn to a computer readable medium (also called machine readable medium and other such variations) typically covers forms of non-transitory tangible media and transitory propagating signals per se in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent. See MPEP 2111.01. When the broadest reasonable interpretation of a claim covers a signal per se, the claim must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. See *In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter) and Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101, Aug. 24, 2009; p. 2.

B) Discussion of the Rejection of Claims 38-43 under 35 U.S.C. § 101 as being directed to Non-statutory Subject Matter

Claims 38-43 were rejected under 35 U.S.C. § 101 as purportedly being directed to non-statutory subject matter wherein the claim recites a processing program that is not claimed as

embodied in a non-transitory computer readable medium. Page 5 of the Answer states:

Because Appellant's disclosure is not limited solely to tangible embodiments, the claimed subject matter, given the broadest reasonable construction, may be a carrier wave comprising of instructions and is, therefore, non-statutory.

The broadest reasonable construction of independent claim 38 clearly does not read on a carrier wave as alleged by the Answer. Specifically, claim 38 recites "A computer-readable medium having program **instructions stored thereon** to perform a method". Appellant submits that under no reasonable construction of claim 38 could a carrier wave have "instructions stored thereon." Likewise, it is not possible for any other non-transitory embodiment to have "instructions stored thereon." The term "stored thereon" indicates the attribute of storage, an attribute that would not exist in a non-permanent, transitory medium. This element in the independent claim clearly limits the claim to tangible embodiments.

The Rejection appears to establish its rejection solely on the term "computer readable medium" and not any limitations of the claim following thereafter. Given the broadest reasonable construction of the claim as a whole, Appellant submits that the recited language of "computer readable medium having program instructions stored thereon" is clearly limited to tangible embodiments of a manufacture. Claims 38-43 are therefore statutory under 35 U.S.C. § 101. Appellant requests reversal of the rejection under 35 U.S.C. § 101.

C) Discussion of the Answer's Grounds of Rejection for Claims 1-8, 10-18, 20-25, 27-33, 35-39, 41-48, and 50-58 under 35 U.S.C. § 102 and § 103

The Answer's detailed grounds of rejection and its discussion of the Loose, Kay, and Poole references appear to misstate the scope and content of the cited prior art. This is accompanied by the Answer's failure to properly ascertain differences between the cited prior art and the claims at issue. As a result, anticipation of the claim by the Loose reference under section 102 cannot be affirmed; likewise the obviousness rejection by the combination of cited references under section 103 cannot be affirmed.

As an illustrative example in respect of the Section 102 rejection, the Answer appears to mischaracterize the spinning reel slot machine in Loose that comprises "a plurality of mechanical rotatable reels and video display" where "[t]he video display provides a video image superimposed on the reels." (Loose, Abstract). The disclosed configuration of a mechanical rotatable reel and a "video image 18 [that] is sufficiently opaque or translucent to cover

the...symbol printed on mechanical reel 12c” (Loose, Col. 5, lines 21-24) is not fully recognized by the Answer.

Instead, lines 20-21 in Page 7 of the Answer newly allege that Loose suggests “multiple images are to be displayed by one or more reels (Fig. 9a) on a display device (Fig. 11).” This ignores the fact that Loose illustrates mechanical rotatable reels, elements 12a, 12b, 12c in Fig. 11, as separate elements from a video display, element 14a-b. Loose also discloses that its “video display 14b and the partially reflective mirror 20 are relatively positioned to project the virtual image in front of the reels 12a, 12b, 12c between the reels and the player.” (Loose, Col. 2, lines 55-58, emphasis added).

In Appellant’s claims, the reels are provided through “video data pixels” of displayed reels and reel symbol elements instead of “mechanical rotatable reels.” Because of the separate mechanical reel and video display elements in Loose, it is impossible for Loose to teach or suggest “at least one symbol element in one or more displayed reels” in combination with “memory storing video data pixel values of the at least one symbol element” as recited in claim 1, “multiple symbol images to be displayed, by one or more video display devices” as recited in claim 17, and like features in other independent claims.

Appellant further submits that the Answer’s rejection of the claimed supplemental graphical element “comprising pre-recorded video information including full motion video of a person, place or thing” fails to provide full patentable weight for this entire element. The Answer appears to improperly redefine the plain meaning of this term by importing limitations from Appellant’s specification. For example, as quoted from Line 19-Line 16 in Pages 8-9 of the Answer:

Examiner notes Appellant fails to provide one comprehensive definition of “the supplemental graphical element comprising pre-recorded video information including full motion video of a person, place, or thing”. Actually, it appears that several portions from various parts of Appellant’s Specification must be read to support Appellant’s claim language. For example:

Page 9 Appellant provides in the context of “video image”, a real image, such as a digital or film based photograph, a frame of a motion picture or a television or video camera image which when displayed give the “appearance of full motion video as opposed to the appearance of a still image”. In another embodiment, displaying the set of video images could result in the appearance of a still video image. In other embodiments, the supplemental graphical element is an animated or rendered image”; and

Page 15, Appellant discloses that the database of “video images” can

represent “a clip from a film or television program” or “other pre-recorded video information (e.g., a non-publicly displayed video of a person, place, or thing)”

Giving the claim its broadest reasonable interpretation in light of the Specification, Examiner finds that the supplemental graphic element comprising pre-recorded video information is pre-recorded video comprising a film or movie frame or clip, graphical element, or rendered image of a person, place, or thing.

The Answer appears to replace terms used in the claims by purporting to import a “definition” from Appellant’s specification, while disregarding the patentable weight of the actual terms used in the recited claims. As apparent in the excerpt above, the Answer’s rejection replaces the recited term “full motion video” with terms covering far broader subject matter, “a film or movie frame or clip, graphical element, or rendered image”—preventing the evaluation of any patentable differences from the prior art related to full motion video standing alone, and disregarding the fact that some of these terms have no “full motion” characteristics.

As an initial matter, the Answer’s allegation that “several portions from various parts of Appellant’s Specification must be read to support Appellant’s claim language” is not only inaccurate, but also irrelevant to the present rejection under 102 and 103 and a reasonable interpretation of the claim. The Answer has withdrawn the previous rejection for failure to comply with the written description requirement under 35 U.S.C. 112, first paragraph. Frankly, support of the recited claim elements in the specification is not at issue.

The correct standard for evaluating claim language is “giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art.” See MPEP § 2111; Phillips v. AWH Corp., 415 F.3d 1303 (Fed. Cir. 2005) (emphasis added). The Answer has attempted to limit the term “supplemental graphical element” by relying exclusively on the disclosure of one specific embodiment, an animated or graphical image. One of ordinary skill in the art, however, would not replace the claimed term “full motion video” with “rendered image” simply because the supplemental graphical element may be an animated or rendered image “in other embodiments”. Page 9 (Paragraph [0044]) of Appellant’s specification does not limit either “supplemental graphical element” or “full motion video” to a stationary image—instead Paragraph [0044] describes:

In one embodiment, displaying the set of video images results in the appearance of full motion video as **opposed to the appearance of a still image.**
(Emphasis added)

Further, Page 15 (Paragraph [0067]) of Appellant’s specification suggests that video

images may include “film,” “television,” or “other pre-recorded video”, fully supporting the claimed terms of “pre-recorded **video information** including **full motion video** of a person, place or thing.” One of ordinary skill in the art reading these passages would recognize that full motion video is distinct from a definition of “rendered image” or “still image” as applied in the Answer’s rejection.

As explained in MPEP § 2111:

Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim.” *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875, 69 USPQ2d 1865, 1868 (Fed. Cir. 2004).... *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (“...The problem is to interpret claims ‘in view of the specification’ without unnecessarily importing limitations from the specification into the claims.”)

Appellant submits that the lengthy discussion in the Answer’s rejection being presented purportedly “to support Appellant’s claim language” instead imports an improper limitation to replace the terms “pre-recorded video information” and “full motion video”, and offers an unreasonable interpretation contrary to the plain meaning of the claim text. The appealed claims unambiguously recite a supplemental graphical element comprising “pre-recorded video information including full motion video of a person, place or thing.”

Further, the Rejection’s interpretation of the specification as applied in the obviousness rejection also appears to be impermissible hindsight used to augment the teachings of the Loose reference. As explained in MPEP § 2142, to “reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’...Knowledge of applicant’s disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the ‘differences,’ conduct the search and evaluate the ‘subject matter as a whole’ of the invention.” (Emphasis added). Interpretation of the Loose reference in light of the description of specific display techniques in Appellant’s specification improperly imports “knowledge gleaned only from applicant’s disclosure.” See MPEP 2145(X)(A).

Page 16, Lines 7-14 of the Answer also fail to fully explain how Loose discloses the claimed supplemental graphical element. Loose’s text on Col. 2, lines 30-33 related to a video image that may be “static or dynamic, and may include graphics such as payout values, a pay

table, pay lines, bonus game features, special effects, thematic scenery, and instructional information” does not include full motion video. Use of the term “dynamic” in this context simply means non-static (such as “flashing” images as disclosed in Col. 4, lines 6-11), but not “full motion video”. Loose, viewed independently from Appellant’s disclosure, does not disclose or suggest a supplemental graphical element “comprising pre-recorded video information including full motion video of a person, place or thing” as claimed.

In respect of the Section 103 rejection, the Answer’s citation to the Kay reference and its combination with the Loose reference also appears to misstate the scope and content of the cited prior art. For example, the Answer explains that Kay provides an “impression of an animation sequence”. The rationale for the Answer’s obviousness combination with Loose is that such an impression offers “the opportunity to experience film and video clips presented in a realistic, aesthetically appealing, and humorous manner.” This rationale does not explain, however, how the “animation sequence” disclosed in Kay comprises any type of video, particularly full-motion video, or might assist with any display of “pre-recorded video information” as claimed.

Kay’s limited techniques of displaying impressions from lenticular printed surfaces are plainly not full motion video or any other type of video. This is expressly acknowledged by the Paragraph 0057 of the Kay reference, discussing use of its techniques to splice a “few discreet images representative of only a very short portion of a film or video clip”, rather than full motion video from such film or video clip. A lenticular animation sequence is not equivalent to the feature of “full motion video” as claimed, and Kay’s disclosure related to using this printing technique cannot be used to provide the full motion video feature missing from Loose.

One of ordinary skill in the art would not be able combine Kay with Loose as set forth by the Answer’s rejection, because Kay’s techniques fail to “superimpose” any images onto a video display. Rather, Kay discloses directly providing images to be viewable “through the lenticular screen” (See Paragraphs 0003, 0090 of Kay). The Answer provides no explanation of how motion that might be perceived from lenticular printing surfaces could be modified to enable superimposition upon the reels of a gaming machine.

Therefore, Appellant respectfully submits that the Answer’s expanded grounds of rejection fail to provide full patentable weight for the recited feature of “pre-recorded video information including full motion video of a person, place or thing.” “All words in a claim must be considered in judging the patentability of that claim against the prior art.” In re Wilson, 424

F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Under such a standard, the Answer's anticipation rejection under §102 and obviousness rejection under §103 has failed to properly reject the display of a "supplemental graphical element comprising pre-recorded video information including full motion video of a person, place or thing."

Accordingly, Appellant respectfully submits that the Answer's interpretation of the claim language and specification is incorrect and not supported by the disclosure of the specification. Based on a proper reading of the claim, in light of the Appellant's specification, the cited prior art does not teach, suggest, or otherwise render obvious every element of the pending claims. Appellant respectfully requests that the rejections of claims 1-8, 10-18, 20-25, 27-33, 35-39, 41-48, and 50-58 under §102 and §103 be reversed in full.

Conclusion

In summary, for the reasons set forth above and in the previously presented Appeal Brief, the claims have been improperly rejected. Therefore, the Appellant respectfully requests that these rejections be reversed, with allowance of the pending claims.

The Appellant submits that all of the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone the Appellant's attorney, Robert M. Hirning, at (612) 371-2110 to facilitate prosecution of this application.

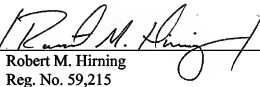
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Respectfully submitted,

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